



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/508,031	04/26/2000	JOSE RAFAEL ESTEBAN DURAN	P/613-111	7856

2352 7590 04/08/2003

OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK, NY 100368403

EXAMINER

COE, SUSAN D

ART UNIT

PAPER NUMBER

1654

DATE MAILED: 04/08/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/508,031

Examiner

Susan Coe

Applicant(s)

ESTEBAN DURAN ET AL.

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-24 is/are pending in the application.
- 4a) Of the above claim(s) 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-21, 23 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. The amendment filed January 13, 2003, has been received and entered. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior Office action.
2. Claims 1-6 and 8-14 have been cancelled.
3. Claims 15-24 have been added.
4. Claims 15-24 are pending.

Election/Restrictions

5. In Paper No. 8, applicant elected with traverse of ethyl acetate and ethanol for species A, phenol and acetoin for species B, and sugar cane for species C. This requirement was made final in Paper No. 12, dated August 13, 2002. Applicant's additional arguments regarding the election of species are noted. However, the requirement is still considered proper because a search of all the species would be burdensome. There are numerous different compositions encompassed by applicant's claims and search of all of these embodiments would be burdensome.
6. Claim 22 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 8.
7. Claims 15-21 and 23-24 are examined on the merits.

Claim Objections

Claim 23 is objected to because of the following informalities: “rhynchophorol” is misspelled as “rynchophorol.” Appropriate correction is required.

Claim Rejections - 35 USC § 103

8. Claims 15-21 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jaffe et al. (Journal of Chem Ecol (1993), vol. 19, no. 8, pp. 1703-1720) in view of Umamo et al. (J. Agric. Food Chem. (1992), vol. 40, no. 4, pp. 599-603) and Nagnan et al. (Oleagineux (1992), vol. 47, no. 3, pp. 135-142) for the reasons set forth on pages 5-7 of the previous Office action.

All of applicant’s arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that a person of ordinary skill in the art would not be motivated to add stabilizers to the composition. However, applicant’s admit that instability of bait based pest attractants is a problem known in the art (see page 8 of the response). A person of ordinary skill in the art would be motivated to add known stabilizers to the bait composition based on the known instability of these compositions.

In addition, applicant’s argue that their composition shows unexpected results in regards to the amount of insects that are captured. Applicant uses Example 1 and Table 1 to support this assertion of unexpected results. However, the compositions used are not commiserate in scope with the elected species of ethanol, ethyl acetate, sugar cane, acetoin, and phenol. The closest composition used by applicant (composition (c) in Example 1) has these ingredients but also contains coconut meat which was not an elected species. In addition, the Example uses a specific pheromone, rhynchophorol, however, there is no one claim that specifically combines

rhynchophorol with the other ingredients of composition c. Therefore, the claims cannot be allowed based on a claim of unexpected results because there is a discrepancy in the scope of the claims and the scope of what is shown to be unexpected. See MPEP section 716.02.

9. No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (703) 306-5823. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30 and on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached on (703) 306-3220. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Susan Coe, Examiner
April 4, 2003


LEON B. LANKFORD, JR.
PRIMARY EXAMINER

IN THE CLAIMS

**Please delete claims 1 through 6 and 8 through 14 without prejudice.
Please add claims 15 through 24 as follows.**

C3 15. (New) An insect attracting composition, said composition controls insects in plants, said insects being selected from insects of the *Coleoptera* order, and said plants being selected from plants of the family *Palmaceae*, sugar cane, banana tree and agaves, said composition comprising:

- (1) a mixture comprising the following components:
 - (A) an organic compound selected from the group formed by methanol, ethanol, ethyl acetate, and mixtures thereof;
 - (B) a vegetable material obtained from a plant, said plant being selected from plants of the family *Palmaceae*, sugar cane, banana tree and agaves, said vegetable material being ground, fermented, and stabilized with a preserving agent; and
 - (C) an organic compound selected from the group formed by isobutyl acetate, acetoin, phenol, guaiacol, menthol, 2-phenylethanol, and mixtures thereof; and
- (2) a pheromone, said pheromone comprising a pheromone which is appropriate for the insects to be controlled.

16. (New) The composition according to claim 15, wherein said organic compound (A) is present in said mixture (1) in an amount comprising between 15% and 85% by weight in respect to the total amount of said mixture (1).

17. (New) The composition according to claim 15, wherein said vegetable material comprises a part of a plant selected from stems, leaves, fruits, and mixtures of these.

18. (New) The composition according to claim 15, wherein said vegetable material (B) is present in said mixture (1) in an amount comprising between 15% and 85% by weight in respect to the total amount of said mixture (1).

Cont
13

19. (New) The composition according to claim 15, wherein said preserving agent is selected from the group consisting of ascorbic acid, citric acid, and mixtures of these.

20. (New) The composition according to claim 15, wherein said organic compound (C) is present in said mixture (1) in an amount of up to 20% by weight in respect to the total amount of said mixture (1).

21. (New) The composition according to claim 15, wherein said mixture (1) comprises:

- 35% by weight of ethyl acetate,
- 35% by weight of ethanol,
- 25% by weight of ascorbic acid stabilized, ground, and fermented sugar cane and/or coconut meat,
- 2.5% by weight of phenol, and
- 2.5% by weight of acetoin.

22. (New) The composition according to claim 15, wherein said mixture (1) comprises:

- 35% by weight of ethyl acetate,
- 35% by weight of ethanol,
- 25% by weight of ascorbic acid stabilized, ground, and fermented sugar cane and/or coconut meat,
- 2.5% by weight of phenol,
- 2.5% by weight of acetoin,
- 2.5% by weight of guaiacol, and
- 2.5% by weight of 2-phenylethanol.

23. (New) The composition according to claim 15, wherein said pheromone is
L rynchophorol. /

24. (New) A method for controlling insects in plants, said insects being selected from insects of the *Coleoptera* order and said plants being selected from plants of the family *Plamaceae*, sugar cane, banana tree and agaves, which comprises applying an insect attracting composition according to claim 15, to a plantation of plants of the family *Palmaceae*, sugar cane, banana tree or agaves to be protected.